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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.														
10/681,803	10/07/2003	Laurent P. Kosbach	03092CON	6636														
7590 Michelle B. Lando Cabot Corporation Billerica Technical Center 157 Concord Road Billerica, MA 01821-7001		01/31/2008	<table border="1"><tr><td colspan="2">EXAMINER</td></tr><tr><td colspan="2">GHALI, ISIS A D</td></tr><tr><td>ART UNIT</td><td>PAPER NUMBER</td></tr><tr><td>1611</td><td></td></tr><tr><td colspan="2"><table border="1"><tr><td>MAIL DATE</td><td>DELIVERY MODE</td></tr><tr><td>01/31/2008</td><td>PAPER</td></tr></table></td></tr></table>		EXAMINER		GHALI, ISIS A D		ART UNIT	PAPER NUMBER	1611		<table border="1"><tr><td>MAIL DATE</td><td>DELIVERY MODE</td></tr><tr><td>01/31/2008</td><td>PAPER</td></tr></table>		MAIL DATE	DELIVERY MODE	01/31/2008	PAPER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/681,803	Applicant(s) KOSBACH ET AL.	
	Examiner Isis A. Ghali	Art Unit 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 13-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/21/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The receipt is acknowledged of applicants' amendment, IDS, and request for RCE, all filed 11/21/2007.

Claims 1-36 are pending.

Claims 13-36 are withdrawn from further consideration being directed to nonelected invention. Election was made with traverse in the reply filed on 01/19/2007.

Claims 1-12 are included in the prosecution.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/21/2007 has been entered.

Double Patenting

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2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 1-36 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-12, 14-25, and 27-38 of copending Application No.

10/959,614. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

4. The examiner acknowledges that applicants' intention to address this rejection if and when the referenced application issues as a patent and the rejection is no longer provisional. However, the "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application.

Specification

5. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

6. Applicants have not indicated revision or making any correction, therefore this objection is maintained.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-6, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by US 3,981,988 ('988).

The present claim 1 is directed to composition comprising about 3% or more fumed alumina particles. Fumed alumina particles are defined by applicants as "a form of alumina that is comprised of substantially spherical particles that are fused or aggregated into larger, irregularly shaped aggregate particles".

US '988 disclosed composition comprising alumina spherical particles having primary particle size from 10-100 millimicrons, usually 10-40 millimicrons, which forms aggregates (abstract; col.1, lines 35-39). The alumina aggregates are included in the composition in an amount from 0.1-40%, and usually between 0.5-10% (col.1, lines 43-47; col.4, lines 7-30). Inherently, aggregates will have particle size within the claimed ranges given that the alumina particles disclosed by the reference having particle size between 10-100 millimicrons, i.e. 10-100 nm.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 7, 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US '988 by itself, or in view of US 2003/0064020 ('020).

The teachings of US '988 are previously discussed in section 8 as set forth in this office action.

However, US '988 does not explicitly teach size distribution of alumina aggregate particles as claimed by claims 7, 10, and 11 or the specific content of alumina phases as claimed by claim 12.

Such size distribution of alumina aggregate particles and specific content of alumina phases, do not impart patentability to the claims, absent evidence to the contrary. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

US '020 teaches alumina particles having δ and θ crystalline form with primary particles thereof having average particle diameter of 5 to 100 nm and secondary particles resulting from aggregation of primary particles having average particle diameter of 50-800 nm. (abstract; paragraphs: 0012, 0013, 0029). The lower limit of the particle diameter as disclosed by the reference meets the claimed particle size of "about 50 nm or more", "about 300 nm or less", and "about 30 μ m or less". In addition, one of ordinary skill in the art would have reasonably expected that a normal distribution of particle sizes would be achieved in the invention of US '020; therefore, within that distribution approximately half of the particles would have a size above or below this value. Since relative term "about" was not given explicit definition, this interpretation of the term "average" meets the limitation of "about 70%". Thus, the taught average particle size range discussed by the reference meets the limitations of claims 7, 10, and 11. The reference further teaches primary particles are loosely aggregated to form secondary particles (paragraph 0079), which reads on fumed alumina because

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applicants disclosed on page 3, paragraph 0016 that fumed alumina is used to refer to alumina primary particles that aggregate to form larger particles. The reference disclosed the use of alumina particles for cosmetic application where scrubbing and smooth feeling are desired (paragraph 0079). The reference further disclosed alumina particles having particle diameter larger than 45 μm (paragraph 0014). The reference disclosed that the particles having diameter larger than 45 μm are contained in an amount about 0.05%, i.e. the particles having diameter less than 45 μm is present in an amount of 99.05%, which meet the requirement of claims 7, 10 and 11. Regarding claim 12, the reference disclosed the particles are mixed form of δ and θ crystalline alumina particles, i.e. 100% of the particles are mixed form, which reads on the limitation of claim 12 that 30% or more are combined δ and θ crystalline particles, and also the preparation may be all 100% δ particles or all 100% θ particles meeting the limitation of claim 12.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide composition comprising alumina particles having particle sizes between 10-100 millimicrons that form aggregate as disclosed by US '988, and provide size distribution of alumina aggregate particles so that the particles having diameter larger than 45 μm are contained in an amount about 0.05%, and the particles having diameter less than 45 μm is present in an amount of 99.05% wherein the particles are mixture form of δ and θ crystalline alumina as disclosed by US '020 because US '020 teaches such alumina particle aggregate is suitable for cosmetic application where scrubbing and smooth feeling are desired, with reasonable

expectation of having cosmetic composition comprising mixture of δ and θ alumina aggregated particles so that the particles having diameter larger than 45 μm are contained in an amount about 0.05%, and the particles having diameter less than 45 μm is present in an amount of 99.05% wherein the composition is effectively suitable for cosmetic application where scrubbing and smooth feeling are desired.

12. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 02/056846 ('486) in view of US '020.

WO '486 teaches cosmetic composition comprising alumina particles have an average particle size of about 10 to about 20 microns, and present in an amount from 0.1 to 10% of the composition (page 4, lines 23-30; page 11, claims 1-10).

WO '486, however, does not teach aggregate of alumina particles to form fumed alumina as claimed by claim 1, and the size and phase distribution of the particles as instantly claimed by claims 5-12.

The aggregated alumina particles, their sizes, and size and phase distribution are all disclosed by US '020. Further US '020 teaches suitability of such aggregated alumina in cosmetic composition, as set forth in section 11 of this office action.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide cosmetic composition comprising alumina particles having particle sizes between 10-20 millimicrons as disclosed by WO '486, and replace alumina particles with aggregate of alumina particles with size distribution that particles having diameter larger than 45 μm are contained in an amount about 0.05%, and the

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particles having diameter less than 45 μm is present in an amount of 99.05% wherein the particles are mixture form of δ and θ crystalline alumina as disclosed by US '020 because US '020 teaches such alumina particle aggregate is suitable for cosmetic application where scrubbing and smooth feeling are desired, with reasonable expectation of having cosmetic composition comprising mixture of δ and θ alumina aggregated particles so that the particles having diameter larger than 45 μm are contained in an amount about 0.05%, and the particles having diameter less than 45 μm is present in an amount of 99.05% wherein the composition is effectively suitable for cosmetic application where scrubbing and smooth feeling are desired.

Response to Arguments

13. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

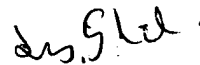
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis A. Ghali whose telephone number is (571) 272-0595. The examiner can normally be reached on Monday-Thursday, 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Isis A Ghali
Primary Examiner
Art Unit 1611



IG

ISIS GHALI
PRIMARY EXAMINER